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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TANK, ANDREW L

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/713,155	Applicant(s) KOBAYASHI ET AL.	
	Examiner Andrew Tank	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13,27,36 and 38-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13,27,36 and 38-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following action is in response to amendment filed June 30, 2008. Claims 8, 27, 36 and 38 were directly amended. Claims 39-44 have been newly added. **Claims 8-13, 27, 36, and 38-44** are pending and have been considered below.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 11, 2008, was filed after the mailing date of the Non-Final Rejection on January 28, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 43 and 44** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 43 recites the limitation: "A computer readable storage medium embodying a program . . ." While this is normally acceptable, applicant further adds from the specification ([0142-0144]): "<<Readable-by-Computer Recording Medium>>" and "<<Data Communication Signal Embodied in Carrier Wave>>" The use of the term "embodying" in the claim language raises issue, in the broadest reasonable interpretation given in light of the specification, to claim 43 being drawn to the program being embodied by the

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carrier wave. A carrier wave is not a series of steps or acts and this is not a process. A carrier wave is not a physical article or object and as such is not a machine or manufacture. A carrier wave is not a combination of substances and therefore not a compilation of matter. Thus, a carrier wave does not fall within any of the four categories of invention. Therefore, claim 43 is not statutory. Claim 44 recites a similar limitation in line 1 and is rejected for similar reasons.

5. Applicant has successfully amended claim 36 to overcome the non-statutory subject matter rejection of January 11, 2008. The corresponding rejection is withdrawn.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claim 41** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- **Claim 41** recites the limitation “the storage unit” in lines 7-8. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 8-13, 27, 36, and 38-44** are rejected under 35 U.S.C. 102(e) as being anticipated by Snapper et al. (US 7,216,292), previously presented as “Snapper”.

- **Claims 8, 27 and 36:** Snapper discloses a communication apparatus, method, and computer readable medium for relaying between a server and a terminal for receiving, from the server on a network, definition information of a screen containing a data input box for data specified by data identifying information and content information to be displayed on the screen together with the data input box and transmitting the data input to the data input box to the server (Abstract, Fig. 2 shows content information to be displayed on the screen together with the data input box), comprising:

- communicating with the server and the terminal via the network (col 6 lines 20-23: “the user of client computer 204 can retrieve web pages from web servers”);
- storing, in a storage unit, the data input to the data input box (col 7 lines 7-11: “associates the values entered by the user”) together with the data identifying information (col 7 lines 10-12: “with the field identifiers and the URL for the web site and stores them in a data structure 207”);
- searching for the data corresponding to the data identifying information from the storage unit on transmitting to the terminal the definition information of the screen containing the data input box for the data specified by the data identifying information (col 7 lines 13-19: “Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers

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- associated with a previous form, and the values associated with those fields are retrieved") and the content information to be displayed on the screen together with the data input box (col 7 lines 13-19: "Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved", form to be displayed, including how the form is laid out is content information to be displayed on the screen together with the data input box, see Fig. 2);
- modifying the searched data into a display state according to the content information (Fig. 4A-4D shows searched data modified according to the content information); and
 - correlating the searched data with the data identifying information specifying the data input box (col 7 lines 17-19: "some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved"),
 - wherein in said communication, definition information of a screen containing a data input box for data specified by data identifying information and content information to be displayed on the screen together with the data input box from the server is received (col 7 lines 12-13: "when the user visits different web site 202 and displays form 260") and the definition information of the screen containing the data input box for data specified by the data identifying information and the content information to be displayed on the screen together with the data input box together with the searched

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- data modified according to the content information and correlated with the data identifying information is sent to the terminal (col 7 lines 13-19: "Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260.").
- **Claim 9:** Snapper discloses the apparatus as in claims 8 above, and further discloses that the storage unit is stored with plural pieces of data input to the data input box in the past(col 8 lines 42-45: "previously used form data values can be stored"), and the control unit sets one piece of data among the plural pieces of data into said data input box (col 7 lines 17-19: "the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260") and adds to the definition information a piece of information for having the remaining data displayed as options in the vicinity of the input box (col 7 lines 29-33: "web browser 206 displays a pop-down list 205b suggesting previously used values for fields having the same or similar name").
 - **Claim 10:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising a determining unit determining a priority order of the data set into the data input box (col 8 lines 4-8: "Heuristics function 206b can be employed to generate suggestion lists according to various heuristics that can be optionally user-controlled. For example, suggested can be displayed in priority order . . . ").

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- **Claim 11:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising an arrangement unit determining a data arrangement order of the data displayed as the options (col 8 lines 4-8).
- **Claim 12:** Snapper discloses the apparatus as in claim 9 above, and further discloses the apparatus comprising an obtaining unit obtaining information for identifying a user of the terminal (col 15 lines 42-44: "the user is logged into the operating system"), wherein the storage unit is stored with the data in a way that relates the data to the information for identifying the user (col 15 lines 42-44: "the user's password can be used to encrypt the data"), and the control unit searches for the data corresponding to the data identifying information for every user (col 15 lines 5-11).
- **Claim 13:** Snapper discloses the apparatus as in claim 9 above, wherein the storage unit is stored with plural pieces of data identifying information related to the data (col 13 lines 19-29: "For example, COMMON NAMES may include three commonly used field identifiers for a user's name"), and the control unit searches for the data by any one piece of data identifying information among the plural pieces of data identifying information (col 13 lines 26-29: "so that when any one of these field identifiers is encountered, all of the values associated with any of them can be automatically suggested").
- **Claim 38:** Snapper discloses a method of relaying definition information of a screen containing an input box, comprising:
 - storing a value entered into an input box of a web page by a user (col 7 line 5-12: "the first time the user of a client computer 204 visits a web site 201 and enters his name, address, and telephone number into form 250") in association with an identifier

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- defining information of a screen containing the input box (col 7 lines 5-12: “modified web browser 206 associates the values entered by the user with the field identifiers and the URL for the web site and stores them into a data structure 207 for future use”); and
- displaying the value as an option for entry into the input box responsive to determination of an access of the web page by the user subsequent to said storing, the value being modified into a display state based on content information prior to said displaying (Fig. 4A-4D show that the value is modified to a display state and then displayed according to the content information), and
 - where said value is retrieved using said identifier and content information as a key and displayed when a comparison of said defining information stored matches definition information requested for said access of the web page (col 7 lines 13-19: “Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved and suggested to the user at the time he or she beings to fill out the form 260.”).
- **Claims 39, 41, and 43:** Snapper discloses a communication apparatus, method, and computer readable medium (Abstract) comprising:
 - displaying a screen containing a data input box for data specified by data identifying information in accordance with definition information on the screen and content

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- information to be displayed on the screen together with the data input box (Fig. 2, col 7 lines 12-13: "when the user visits different web site 202 and displays form 260");
- storing the data inputted to the data input box (col 7 lines 7-11: "associates the values entered by the user") together with the data identifying information (col 7 lines 10-12: "with the field identifiers and the URL for the web site and stores them in a data structure 207");
 - searching for the data corresponding to the data identifying information from the storage unit when having the screen displayed (col 7 lines 13-19: "Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved") and modifying the searched data into a display style according to the content information (Fig. 4A-4D shows searched data modified according to the content information);
 - setting the searched data into the data input box specified by the data identifying information (Fig. 4A-4D shows searched data modified and set into the data input box according to the content information); and
 - obtaining information for identifying a user (col 15 lines 42-44: "the user is logged into the operating system"), wherein said storing includes storing the data in a way that relates the data to the information for identifying the user (col 15 lines 42-44: "the user's password can be used to encrypt the data"), and said searching includes

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searching for the data corresponding to the data identifying information for every user (col 15 lines 5-11).

- **Claims 40, 42, and 44:** Snapper discloses a server apparatus, method, and computer readable medium for transmitting to a terminal on a network, definition information of a screen containing a data input box for data specified by data identifying information and content information to be displayed on the screen together with the data input box and receiving the data input to the data input box from the terminal (Abstract, Fig. 2 shows content information to be displayed on the screen together with the data input box), comprising:
 - communicating with the terminal via the network (col 6 lines 20-23: “the user of client computer 204 can retrieve web pages from web servers”);
 - storing, in a storage unit, the data input to the data input box (col 7 lines 7-11: “associates the values entered by the user”) together with the data identifying information (col 7 lines 10-12: “with the field identifiers and the URL for the web site and stores them in a data structure 207”);
 - searching for the data corresponding to the data identifying information from the storage unit when transmitting to the terminal the definition information of the screen containing the data input box for the data specified by the data identifying information (col 7 lines 13-19: “Consequently, when the user visits different web site 202 and displays form 260, modified web browser 206 recognizes that some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved”);

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- modifying the searched data into a display state according to the content information (Fig. 4A-4D shows searched data modified according to the content information); and
- correlating the searched data with the data identifying information specifying the data input box (col 7 lines 17-19: "some of the field identifiers user in form 260 are the same as or similar to field identifiers associated with a previous form, and the values associated with those fields are retrieved");and
- setting the searched data into the data input box (Fig. 4A-4D shows searched data modified and set into the data input box according to the content information).

Response to Arguments

10. Applicant's arguments filed June 30, 2008, have been fully considered but they are not persuasive.

11. Applicant argues, on pages 9-10, that:

"Claim 8 of the present application, as amended, recites "searching for the data corresponding to the data identifying information..., modifying the searched data into a display style according to the content information, and correlating the searched data modified according to the content information with the data identifying information specifying the data input box."

Applicants respectfully submit that Snapper does not disclose or suggest at least this feature of claim 8. See also claims 27 and 36 reciting similar features.

Instead, Snapper merely provides a down list (205b) suggesting previously used values in their form for fields having the same or a similar name (see, col. 7, lines 22-33). The value associated with the fields in Snapper is simply retrieved and suggested to the user (see, col. 7 lines 6-11 and lines 40-51). In other words, Snapper is silent regarding "modifying the searched data into a display style", as taught by the claimed invention."

The examiner respectfully disagrees. As shown in the rejection of claims 8, 27, and 36 above, Snapper, through placing the retrieved and suggested words in a particular format, that of a drop down list in the above embodiment, the words, i.e. searched data, are modified into a display style by the content information, i.e. the particular format of form display. The argument

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is not persuasive. Applicant's remaining arguments regarding claims 38 and new claims 39-44 argue similar rationale and are unpersuasive for the similar reasons.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Tank whose telephone number is 571-270-1692. The examiner can normally be reached on Mon - Thur 0830-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. T./

Examiner, Art Unit 2175

September 4, 2008

/Kieu D Vu/

Primary Examiner, Art Unit 2175